



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,722	04/09/2004	Dave Whelan	040214-000100US	1512

20350 7590 10/03/2005

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER
----------

PURVIS, SUE A

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,722

Applicant(s)

WHELAN, DAVE

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-21, 23-32 and 34-38 is/are rejected.
- 7) ☒ Claim(s) 11, 22 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10 May 2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, 12-15, 18-21, 23-30, 32, 34, and 38 are rejected under 35

U.S.C. 102(b) as being anticipated by Schlinkmann et al. (US Patent No. 5,938,890).

Schlinkmann discloses a method and apparatus for removing components from a liner. Regarding claim 1, Schlinkmann discloses a roller device (3) adapted for moving the liner (26), a gripper (12) adapted for selectively gripping the liner, and a placement actuator (13) to engage the desired component. The gripper (12) and actuator (13) are coupled through the controller (32) which is adapted for moving the actuator (13) when the roller device (3) moves the liner. (Figures 1 and 2.)

Regarding claim 2, this claim amounts to functional language and fails to structurally define applicant's invention. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Regarding claim 3, Schlinkmann includes a base (22) against which the liner (26) is gripped by the gripper (12). The base includes a peel edge (6) connected thereto over which the liner (26) is moved.

Art Unit: 1734

Regarding claim 4, in the embodiment in Figure 1 Schlunkmann shows a roller peeler edge (7) which is not fixed. However, the embodiment in Figure 7 has a fixed peeler edge (35).

Regarding claim 5, the roller device (3) includes a pinch roller and the base (22) is between the roller (3) and gripper (12).

Regarding claim 6, the peeler (6) with the spring (8) provides a back pressure generally resistive to the roller device moving the liner.

Regarding claim 7, the actuator includes a vacuum chuck (13).

Regarding claim 8, Figure 3 shows the hole pattern for the chuck (13).

Regarding claims 9 and 10, Schlunkmann includes a sensor (11) for sensing the components (21) on the liner (26). Claim 10 defines a functional feature of the sensor which the sensor in Schlunkmann is capable of performing.

Regarding claim 12, the liner in Schlunkmann is a releaser liner.

Regarding claim 13, the components are removably adhered thereto.

Regarding claims 14 and 15, the actuator (13) engages the component while it is adhered to the liner (26) and retains it when the liner is moved. (See Figures 4 and 5.)

Regarding claim 18, Schlunkmann includes a controller (32) coupled to the roller device through the air cylinder (10).

Regarding claim 19, the controller (32) is also coupled to the gripper (12).

Regarding claim 20, the actuator (13) is coupled to the drive (14) which causes the actuator (13) movement.

Regarding claim 21, the actuator (13) and gripper (12) are coupled together through the controller (32).

Regarding claim 23, Schlunkmann discloses means for moving the liner over the peeler edge (9), a placement device (13) for engaging the desired component while adhered

Art Unit: 1734

to the liner (26), and a gripper (12) adapted for selectively gripping the liner (26). The movement of the gripper and the placement device amounts to functional language and fails to structurally define applicant's invention over the prior art.

Regarding claims 24, the actuator (13) retains the component when the liner is moved. (See Figures 4 and 5.)

Regarding claim 25, Schlinkmann includes a sensor (11) for sensing the components (21) on the liner (26).

Regarding claim 26, the actuator (13) or placement device places the component (21) onto the desired target (18).

Regarding claim 27, Schlinkmann discloses a method of transferring components (21) from a liner (26) to a desired target (18). The liner is positioned under the actuator (13) with a component thereon, the gripper (12) holds the liner (26) and the actuator grips the component, the liner (26) is moved over the peel edge (6) which is retracted, the actuator (13) holds the component (21), and thereafter places it onto the article.

Regarding claim 28, the component in Schlinkmann is substantially free of deformations.

Regarding claim 29, Figure 3 shows the suction holes pattern on the chuck (13).

Regarding claim 30, the actuator (13) moves to engage the product (18) for the relative movement.

Regarding claim 32, sensor (11) senses the position of the component before it engages with the actuator (13).

Regarding claim 34, the controller (32) controls the movement of the actuator (13) as it retains the component (21).

Regarding claim 38, the actuator (13) and gripper move the same distance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann as applied to claim 1 above, further in view of Vicktorius et al. (US Patent No. 6,009,926).

Schlinkmann does not disclose having the actuator able to rotate the component on the target device.

Vicktorius discloses a labeling machine with a suction holder (3) which rotates (f2) to allow for more flexibility in the positioning of the label (4) onto the package (2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have actuator in Schlinkmann rotate, because Vicktorius teaches that it is known to have the holder to rotate to ensure the label is oriented properly on the package and in the desired position.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann as applied to claim 1 above, and further in view of McNestry (US Patent No. 6,368,446 B1).

Schlinkmann teaches that the labels are generally supplied pre-printed or they may be printed in the label dispensing apparatus. (Col. 1, lines 10-13.) The method and device of Schlinkmann does not include printing the labels.

McNestry shows an apparatus where the labels (11) are printed on by a printer (26) after they are unrolled from a supply roll (25) and before the labels are peeled from a release liner and placed on a package (12).

Art Unit: 1734

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a printer in Schlinkmann if the artisan wishes to print the label before placing it on a package, because this is taught in McNestry and Schlinkmann admits that it is a well known alternative to using pre-printed labels.

6. Claims 31, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann as applied to claim 27 above, and further in view of McNestry.

Schlinkmann does not detail if the packages are conveyed past the actuator.

McNestry shows it is known in the art to move the packages past an applicator on a conveyor.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to move the packages past the actuator in Schlinkmann on a conveyor as is done in McNestry, because machines like the one in Schlinkmann are commonly positioned next to a conveyor with articles to be labeled being conveyed past the machine.

Regarding claims 35 and 36, McNestry shows that when there is a conveyor being used, multiple packages are advanced past the applicator.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann as applied to claim 27 above, and further in view of McNestry.

Schlinkmann teaches that the labels are generally supplied pre-printed or they may be printed in the label dispensing apparatus. (Col. 1, lines 10-13.) The method of Schlinkmann does not include printing the labels.

McNestry shows an apparatus where the labels (11) are printed on by a printer (26) after they are unrolled from a supply roll (25) and before they are peeled from a release liner and placed on a package (12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to print the labels in Schlinkmann while on the liner, because this is

Art Unit: 1734

taught in McNestry and Schlinkmann admits that it is a well known alternative to using pre-printed labels.

***Allowable Subject Matter***

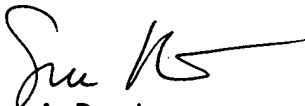
8. Claims 11, 22, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
September 28, 2005